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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,396	09/18/2003	Theodore Benderev	MEDTR-001A	9330

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STETINA BRUNDA GARRED & BRUCKER
75 ENTERPRISE, SUITE 250
ALISO VIEJO, CA 92656

EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

MAIL DATE	DELIVERY MODE
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04/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/666,396	Applicant(s) BENDEREV, THEODORE	
	Examiner Jeffrey G. Hoekstra	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 7, 9, 10, 12-15, 17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8, 11, 16, 18 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/13/2007 has been entered.

Notice of Amendment

2. In response to the amendment filed on 02/13/2007, amended claim(s) 1, 11, 21, and 24 is/are acknowledged. The current rejections of the claim(s) 1-26 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Election/Restrictions

3. This application contains claims directed to the following patentably distinct species:

- Species A: "lattice structure" embodiment drawn to Figures 2A and 2B and
- Species B: "compressive foam" embodiment drawn to Figures 3A and 3B.

4. The species are independent or distinct because they are substantially dissimilar and structurally divergent means for measuring pressure within an anatomical structure.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 11, and 21-26 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.
MPEP § 809.02(a).

5. During a telephone conversation with Sean O'Neill on 04/24/2007 a provisional election was made without traverse to prosecute the invention of Species B, claims 1, 6, 8, 11, 16, 18, and 21-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-5, 7, 9, 12-15, 17, and 19-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

6. Claim 1 is objected to because of the following informalities: the positive recitation of "said structure" in line 5 appears to lack antecedent basis and may render the claim indefinite. The Examiner notes Applicant may have intended it to read "said anatomical structure". Appropriate correction is required.
7. Claims 22 and 23 are objected to because of the following informalities: the positive recitation of "said member" in lines 3 and 4 appears to lack antecedent basis and may render the claims indefinite. The Examiner notes Applicant may have intended it to read "said encapsulated member". Appropriate correction is required.
8. Claims 25 and 26 are objected to because of the following informalities: the positive recitation of "said member" in lines 4 and 5 appears to lack antecedent basis and may render the claims indefinite. The Examiner notes Applicant may have intended it to read "said encapsulated member". Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Claims 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
11. Claim 25 recites the limitation "said balloon member" in line 4. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 26 recites the limitation "said balloon" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 6, 8, 11, 16, 18, and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. (US 5,752,522, hereinafter Murphy).

15. For claims 1, 11, 21, and 24, Murphy discloses an anatomical pressure-sensing device (10) (as best seen in Figure 1) and methods of use thereof, comprising:

- providing a pressure sensor (24,26) having a link (34) extending therefrom for transmitting a signal, said sensor being positionable within and between anatomical structures and said sensor measuring and producing the signal corresponding to the pressure of compression exerted by/against said anatomical structures (column 5 lines 40-53);
- providing a monitor (column 3 lines 19-38, column 7 lines 54-56) coupled to said link for receiving said signal and providing a quantifiable indication of said measured signal;
- inserting said sensor within said anatomical structure (as best seen in at least Figures 1 and 2); and

- monitoring said signal generated by said sensor (column 3 lines 19-38, column 7 lines 54-56).

16. For claims 6, 8, 16, and 18, Murphy discloses an anatomical pressure-sensing device, wherein said pressure sensor comprises a member having a quantity of compressive foam, said compressive foam incrementally transitioning between a first expansive state when a first baseline amount of pressure is applied and a second compressed state having a reduced volume corresponding to a second higher externally applied pressure as a result of an externally applied higher pressure (column 9 lines 12-35).

17. For claims 22-23 and 25-26, Murphy discloses an anatomical pressure-sensing device and methods of use thereof, wherein said sensor comprises an encapsulated member (20) having said internal pressure/volume sensors (26) and generating a signal corresponding to the externally applied pressure and/or volumetric space (column 5 lines 40-53).

18. Claims 1, 11, 21, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Valley et al. (US 6,251,093 B1, hereinafter Valley).

19. For claims 1, 11, 21, and 24, Valley discloses an anatomical pressure-sensing device (300) (as best seen in Figure 7A) and methods of use thereof (column 7 lines 8-43), comprising:

- providing a pressure sensor (330,331,350) having a link (334,336,339,341,352,354) extending therefrom for transmitting a signal, said sensor being positionable within

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and between anatomical structures and said sensor measuring and producing the signal corresponding to the pressure of compression exerted by/against said anatomical structures (column 17 line 23 – column 19 line 43);

- providing a monitor (353) coupled to said link for receiving said signal and providing a quantifiable indication (357) of said measured signal (column 17 line 23 – column 19 line 43);
- inserting said sensor within said anatomical structure (as best seen in at least Figures 1, 2, 4, 13, 15, and 16); and
- monitoring said signal generated by said sensor (column 17 line 23 – column 19 line 43).

Response to Arguments

20. Applicant's arguments with respect to claims 1, 6, 8, 11, 16, 18, and 21-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

21. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Gellman et al. (US 7,025,772 B2) and Naghavi (US 2004/0102722 A1) disclose devices and methods for determining pressure exerted within and between anatomical structures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is

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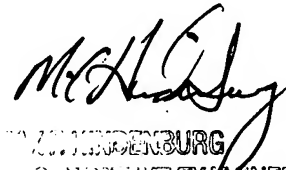
(571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MAX F. HINDENBURG
PATENT EXAMINER
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